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In the Application of:

Grooms, *et al.*

Serial No.: 09/722,205

Filed: November 25, 2000

For: "Cortical Bone Cervical Smith-
Robinson Fusion Implant"

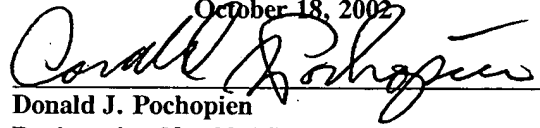
Group Art Unit: 3732

Examiner: E. Robert

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on this date:

October 18, 2002


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ELECTION OF INVENTION UNDER 35 U.S.C. § 1.121

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Official Communication of 09/18/02 ("Official Communication"), for which a response was due 10/18/02, the Applicants respond to the restriction requirement imposed by the Patent Office by making an election of an invention.

In the Official Communication, the Patent Office says that there are multiple inventions being claimed and that the Applicants are required to claim one of them for examination. The Patent Office has divided the claims into the following three groups of inventions:

- I. Claims 1-28 and 32, directed to a spinal spacer;
- II. Claims 29 and 30, directed to a method of making at least one implant;
- III. Claim 31, drawn to a method for inducing fusion of cervical vertebrae.

In addition, the Patent Office has further divided the above Groups into the following list of species:

- I. Figures 1a-1b
- II. Figures 1c-1e
- III. Figures 6a-6c
- IV. Figures 6d-6f
- V. Figures 6g-6i
- VI. Figure 7a
- VII. Figure 8a
- VIII. Figures 8d-8g
- IX. Figures 12a-12d
- X. Figures 13a-13f
- XI. Figures 14a-14d
- XII. Figures 15a-15f
- XIII. Figures 16a-16d
- XIV. Figures 17a-17f

The Applicants elect, with traverse, to prosecute the claims of Group I, Species IX, drawn to claims 1-28 and 32 and directed to a spacer as depicted in Figures 12a-12d.

The Applicants traverse the Examiner's assertion that Groups I-III are patentably distinct for the reasons set forth below. Furthermore, Applicants assert that the restriction between Groups I and III is improper because the Examiner has not given any reasons to support the restriction. See MPEP § 803. ("Examiners must provide reasons and/or examples to support conclusions.") Moreover, Applicants respectfully state that a search and examination of Groups I-III would not represent a serious burden on the Examiner. See MPEP § 803. ("There are two criteria for a proper requirement for restriction between patentably distinct inventions: the invention must be independent or distinct as claimed; and there must be a serious burden on the Examiner if a restriction is required.") Therefore,

restriction between Groups I, II, and III is improper. Applicants respectfully request rejoinder of Group I-III and examination of Groups I-III on the merits.

The Examiner alleges that Groups II and I are related as process of making and product made. The Applicants respectfully disagree. Group I, drawn to a spinal spacer, as recited in claims 1-28 and 32 cannot be made by a process other than that of Group II, a method of making at least one implant, as recited in claims 29 and 30. Therefore, the inventions of Groups I and II are not patentably distinct.

The Examiner alleges that Groups II and I are related as process and apparatus for its practice. The Applicants respectfully disagree. Group II, drawn to a method of making at least one implant, as recited in claims 29 and 30 cannot be practiced by another materially different apparatus other than that of Group I, drawn to a spinal spacer, as recited in claims 1-28 and 32. Therefore, the inventions of Groups I and II are not patentably distinct.

The Examiner alleges that Groups II and III are unrelated. The Applicants respectfully disagree. Group II, drawn to a method of making at least one implant, as recited in claims 29 and 30, is capable of use together with Group III, a method for inducing fusion of cervical vertebrae, as recited in claim 31. Therefore, the inventions of Groups II and III are not patentably distinct.

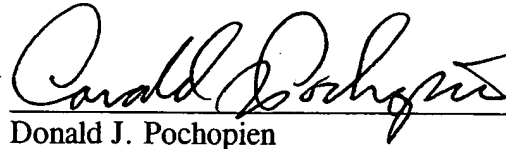
For the reasons discussed above, Applicants respectfully submit that the requirement for restriction between Groups I-III is improper. In addition, because the Examiner has not given any reasons to support the restriction between Groups I and III, the requirement for restriction between Groups I and III is also improper. Furthermore, Applicants respectfully submit that a search and examination of Groups I-III together would not represent a serious burden on the Examiner. Therefore, Applicants respectfully request rejoinder of Group I-III and examination of Groups I-III on the merits.

Additionally, Applicants are cofiling an amendment herewith, adding generic claims which link one or more of the restricted species. Since there are currently no generic claims, addition of generic claims linking the restricted species is proper.

Respectfully submitted,

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